

REMARKS

The present Amendment responds to the Office Action dated February 2, 2006 having a shortened statutory period for response set to expire May 2, 2006. A one (1) month extension of time to respond was previously filed along with Applicants' Petition for Unintentionally Delayed Claim For Priority Pursuant to 37 C.F.R. §§ 1.55(c) and 1.78(a)(3), which was filed on May 9, 2006. Accordingly, Applicants' Amendment is believed to be timely if filed by June 2, 2006.

In the Office Action, claims 1-23 were pending with claims 16 and 23 withdrawn from consideration due to the previous restriction requirement. At the outset, the Examiner rejected claim 21 under 37 CFR 1.75(c) as being an improper dependent claim. The Examiner will note that claim 21 has been cancelled. Also, the Examiner objected to the language "and including" in claim 4. Claim 4 has now been amended to remove the this language.

Turning now to the substantive rejections in the Office Action, the Examiner has rejected claims 1-15 and 17- 22 under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Patent No. 5,719,146 to Shiokawa et al. Specifically, the Examiner takes the position that Shiokawa et al. "*suggest* a compound where A = 2-chloropyridin-5-yl; Z1 = O; X = N; Y = NO₂; R1 = H; and R2 = CH₃." (emphasis added). However, as the Examiner acknowledges, "Shiokawa does not exemplify a compound wherein Z1 = oxygen." The Examiner goes on to assert "...it would have been obvious to one having ordinary skill in the art to have made the invention wherein Z1 is oxygen at the time of Shiokawa's invention. One would have been motivated to do this since Shiokawa strongly suggests the compound." Applicants respectfully disagree and request that the Examiner reconsider the rejection of the claims in view of the following arguments.

The Shiokawa et al. patent contains a disclosure of a broad generic class of compounds, which, in its broadest form, encompasses within its scope the 1,3,5-oxadiazine compounds. However, as the Examiner acknowledges in the Office Action, the Shiokawa et al. patent does not contain a specific disclosure of the compound according to Applicants' invention. Rather, Shiokawa et al. disclose a broad genus, which encompasses a vast number of compounds including triazines, morpholines, 1,2,5-oxadiazines, thiazines and 1,2-oxazines. In addition to the generic disclosure of compounds, Shiokawa et al. provide a list of forty compounds which can be prepared by the examples set forth in the specification. (See, e.g., Table 1 at cols. 9-17). Not a single one of the listed compounds is the compound of the present invention. Moreover, The broad genus disclosed in Shiokawa et al. encompasses in excess of a million compounds. Even the description of "preferred" compounds at column 2, lines 4 to 15, includes more than one thousand compounds.

The Examiner notes claim 1 of the reference for support of the present rejection of the claims. However, Applicants submit that claim 1 of Shiokawa et al. encompasses approximately 160 compounds and, more importantly, the disclosure itself does not describe any of these 160 compounds. One of ordinary skill in the art would only be able to arrive at Applicants' claimed compound with the aid of hindsight reasoning, which may help one to piece together the structure set forth in the claims by selecting the appropriate variables in formula I. However, and more importantly, the Shiokawa et al. specification provides no direction or description to do so.

Based upon the foregoing, then, Applicants submit that Shiokawa et al. do not clearly convey to those skilled in the art the information needed for one of ordinary skill in the art to arrive at Applicants' claimed invention, particularly in view of the breadth thereof. Accordingly, one of ordinary skill in the art would not arrive at the presently claimed invention without resorting to hindsight reasoning, which can not properly support a 35 U.S.C. § 103(a) rejection.

In addition, claims 1-15 and 17- 22 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,376,487. Claims 1, 17, and 22 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,852,012. However, Applicants submit that the present application claims priority through both of these patents. As mentioned above, Applicants have recently filed a Petition for Unintentionally Delayed Claim For Priority Pursuant to 37 C.F.R. §§ 1.55(c) and 1.78(a)(3) to correct the priority claim currently on file. The petition is currently pending before the Petitions Office.

The priority information of the present application is as follows:

This application is a divisional of Application No. 09/669,209, filed September 25, 2000, now Pat. No. 6,627,753, which is a divisional of Application No. 09/136,664 filed August 19, 1998, now Pat. No. 6,376,487, which is a divisional of Application No. 08/464,931 filed June 05, 1995, now Pat. No. 5,852,012, which is a divisional of Application No. 08/270,612, filed July 5, 1994, now abandoned, which is a divisional of Application No. 08/091,801, filed July 14, 1993, now abandoned, which claims the benefit of Swiss Application No. 2315/92-1, filed July 22, 1992, now abandoned.

In the previous cases, the Office has required a restriction of the claims. Should Applicants petition be granted, Applicants believe that the current double patenting rejection would be rendered improper. Specifically, MPEP § 804.01, p. 800-30 provides:

The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction.

Accordingly, Applicants submit that the double-patenting rejection is improper, at least until or unless the Petitions Office denies Applicants' petition.

Based upon the foregoing then, Applicants submit that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

USPTO Customer No. 26748
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409
(336) 632-6049

/Rebecca A. Gegick/
Rebecca A. Gegick
Attorney for Applicants
Reg. No. 51,724

Date: June 2, 2006